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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/257,272 02/25/99 HU

J PF112P2D2

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EXAMINER

SAUD, C

ART UNIT

PAPER NUMBER

1647

DATE MAILED:

09/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/257,272

Applicant(s)
HU et al.

Examiner
Christine Saoud

Group Art Unit
1647



☒ Responsive to communication(s) filed on Jul 18, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 22-400 is/are pending in the application.

Of the above, claim(s) 22-32 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 33-400 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 and 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Status of Claims

1. Claims 2-21 have been canceled and claims 33-400 have been added as requested in the amendment of paper #8, filed 18 July 2000. Claims 33-400 are pending in the instant application.

Election/Restriction

2. Applicant's election with traverse of Group II in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the search of the inventions of Groups I and III-XII would not entail a serious burden and that "no arguments have been made explaining why it would impose an undue burden". This is not found persuasive because an application may properly be required to be restricted to one of two or more claimed invention if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04 (j)) or distinct (MPEP § 806.05 - § 806.05(i)). The Examiner has shown that the inventions are distinct for the reasons in the previous Office action (see paper #5). Furthermore, M.P.E.P. § 803 provides that the separate classification (i.e., class and subclass) of distinct inventions is sufficient to establish a *prima facie* case that the search and examination of the plural inventions would impose a serious burden upon the Examiner; such separate classification was set forth in the Office action mailed 18 November 1999 (Paper #5). Applicant has offered no evidence to rebut this showing. Applicant's arguments that "the searches for polypeptides, polynucleotides, and antibodies, etc. commonly overlap and therefore, the search and examination of a polypeptide sequence, and

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remaining groups would not entail a serious is not persuasive because the searches for each group are not coextensive as indicated by their separate classification. Therefore, a *prima facie* case for a serious search burden was presented in paper #5 and Applicant has offered no evidence to rebut this showing.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 22-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 7. Furthermore, the method claims imbedded in claims 33-400 will also be withdrawn (the claims are as numbered in Applicant's response at page 32) once the issue of multiplicity is resolved (see below).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 33-400 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

MPEP 2173.05(n) states that "[a]n unreasonable number of claims, that is, unreasonable in view of the nature and scope of applicant's invention and the state of the art, may afford a basis

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for a rejection on the ground of multiplicity. A rejection on this ground should include all the claims in the case inasmuch as it related to confusion of the issue.” The instant application now contains 414 pending claims. In view of the nature and scope of the invention, directed to a polypeptide, compositions thereof, and methods of use, 368 claims are deemed to be unreasonable. Applicant should select 50 claims for the purpose of examination.

Applicant is directed to issued patent 5,932,540 in which the currently claimed subject matter has already been allowed. The instant claims repeat what is already claimed and patented. The instant claims further are directed to the same polypeptide and many of the claims do not appear to further limit the polypeptide that is being claimed.

Based on the 186 claims which have already issued in ‘540 and the pending 368 claims of the instant application, it appears that an unreasonable number of claims, that is, unreasonable in view of the nature and scope of applicant’s invention and the state of the art, affords a basis for a rejection on the ground of multiplicity. Therefore, the claims are rejected for the reasons provided above.

6. The method claims of this application conflict with claims 22-110 of Application No. 09/107,997 and with the method claims in 09/219,442. The protein claims of this application conflict with the protein claims of 09/219,442. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the

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conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Conclusion

7. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 7AM to 3PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556. If this number is out of service, please call the Group receptionist for an alternate number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

September 18, 2000

**CHRISTINE SAOUD
PATENT EXAMINER**

Christine Saoud